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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,341	03/09/2000	David Leigh Donoho	UNIV0001	3293

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GLENN PATENT GROUP  
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EXAMINER
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WINDER, PATRICE L

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/522,341

Applicant(s)

DONOHO ET AL.

Examiner

Patrice Winder

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.  
4a) Of the above claim(s) 16-23 and 37-44 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-15, 24-36, 45 and 46 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 6-14, 24-25, 29-35, 45-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunt et al., USPN 5,893,091 (hereafter referred to as Hunt).

3. Regarding claim 1, Hunt taught in a system including an advice consumer for gathering broadcast information from a communications medium and a reader associated with said advice consumer for determining relevance of said broadcast information (abstract), a communications system comprising:

an advice provider which broadcast information over a communications medium to target situations based on an arbitrary combination of computationally verifiable conditions of an advice computer and its environment (column 7, lines 53-64);

wherein said advice consumer is advised of said information only if said information meets certain predetermined relevance criteria as determined by said reader (column 7, line 64 – column 8, line 5);

wherein said advice provider broadcast highly targeted advice the relevance of which to an advice consumer is determined by said reader without comprising individual

privacy and without learning of identity and attributes of said advice consumer (column 8, lines 6-16); and

wherein said environment includes data of a sensitive or private nature (column 6, lines 10-30).

4. Regarding dependent claim 2, Hunt taught said relevance criteria further comprising:

a set of any of demographic, biologic, geographical, and other empirical models used to infer statistically that a certain condition is highly likely to be true, even when it can not be verified by direct calculation, measurement, or formal logical deduction, by using any of the information which may be publicly available, information present in a user profile, information directly measurable, or information available from third parties (column 5, lines 5-26).

5. Regarding dependent claim 3-4, Hunt taught said data comprises financial data and transaction data (column 6, lines 10-30).

6. Regarding dependent claim 7, Hunt further taught comprising:

an inspector library containing executable code which is invoked as part of a continual relevance evaluation process (column 9, lines 11-21); and

one or more remote inspector methods for remotely performing any of mathematic-logical calculations, executing computational algorithms, returning the results of system calls, accessing the contents of storage device, and querying said communicating devices (column 9, lines 41-56).

7. Regarding dependent claim 8, Hunt taught said one or more remote inspector methods comprising any of medical records inspectors, remote financial records inspectors, and remote drug prescription inspectors (column 6, lines 10-30).

8. Regarding dependent claim 9, Hunt taught wherein said one or more remote inspector methods comprise server side components and client side components(column 12, lines 57-65, column 14, lines 39-52).

9. Regarding dependent claim 10, Hunt taught said one or more remote inspector methods comprise server side components for providing remote information access (column 15, lines 47-53).

10. Regarding dependent claim 11, Hunt taught a consumer receives advice via said remote information access and said consumer's personal information is included in said server side components, only if said consumer authorizes inclusion of said consumer's personal information in said server side components (column 10, lines 6-14).

11. Regarding dependent claim 12, Hunt taught further comprising:  
means for consumer subscribing to advice sites which make use of said remote inspectors (column 2, lines 50-55, column 4, lines 44-47).

12. Regarding dependent claim 13,Hunt taught wherein a remote inspector method on a consumer machine establishes a connection with an information server and performs one or more queries to determine if relevant information is present on said information server with regard to said consumer (column 9, lines 61-67), and wherein information is gathered by said server (column 8, lines 6-16).

13. Regarding dependent claim 14, Hunt taught a connection between said client and said server is secured by a cryptographic protocol (column 15, lines 46-54).

14. The language of claims 24-25, 28-35 is substantially the same as the language of claims 1-3, 6-14, above. Therefore, claims 24-25, 28-35 are rejected on the same rationale as previously rejected claims 1-3, 6-14, above.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 5-6 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt in view of Wagner, USPN 6,092,102 (hereafter referred to as Wagner).

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18. Regarding dependent claims 5 and 26, Hunt does not specifically teach said data comprise health or medical data. However, Wagner taught said data comprise health or medical data (column 6, lines 10-14, column 7, lines 13-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Wagner's health or medical data in Hunt's system for distributing timely information would have expanded system utility. The motivation would have been to improve the quality of health care by providing needed healthcare information.

19. Regarding dependent claim 6 and 27, Wagner taught said relevance criteria comprise assertions that certain combinations of prescription drugs, certain interactions between genetic or blood type information or other personal medical history and certain behavior or illness or drug prescriptions (column 8, lines 23-34).

20. Claims 15 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt.

21. Regarding dependent claims 15 and 36, Hunt taught the client requesting information by a server using a subscription protocol (column 11, lines 26-35). "Official Notice" is taken that the identity of client requesting information is authenticated by a server using an authentication protocol is well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating an authentication protocol in Hunt's system for distributing sensitive information would have improved system security. The motivation would have been to better private channels of information.

***Response to Arguments***

22. Applicant's arguments with respect to claims 1-15, 24-26 and 45-46 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

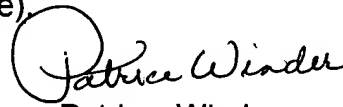
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patrice Winder  
Primary Examiner  
Art Unit 2145

November 14, 2005